

REMARKS

This responds to the Office Action mailed on April 15, 2008.

§112 Rejection of the Claims

Claims 1, 5, 10 and 15 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

The Office Action alleges that “a length of the electronic communication” is indefinite. Applicants respectfully traverse regarding the indefiniteness of the quoted passage. Applicants submit that it is clear what “a length” refers to, as such language is understood to those skilled in the art as well as in common usage English language. The Examiner stated that “A length of the electronic communication can be construed as a string of data present within the communication”, which is incorrect. One of ordinary skill in the art would not equate a “string of data” as “a length”, but may find that a “string of data” has “a length”. The dictionary definition also has multiple definitions of “length”, none of which coincide with the Examiner’s interpretation. Such examples similar to context of the claim are: “a length of a river”, “a length of a word”, and “a length of an object”.

§102 Rejection of the Claims

Claims 1-4 and 6-20 were rejected under 35 U.S.C. § 102(a) for anticipation by Aronson et al. (U.S. Patent No. 6,654,787).

The Applicants wish to thank the Examiner for the suggested amendment to the claims of incorporating from the specification the formula for computing a length into the independent claims. However, such recommendation to amend will be declined at this time as doing so would unduly limit the scope of the claim. The issue currently in question is not what a length is limited to or how a length can be found, but what constitutes as “a length”.

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of*

California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim.” Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))

Applicants respectfully submit that the Office Action did not make out a prima facie case of anticipation for the following reasons:

“The identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

Claim 1 recites: “generating one or more signatures using a length of the electronic communication and the URLs extracted.” In contrast, Aronson describes “Referring again to FIG. 7, in one embodiment, each one of the rule handling filter modules 720-760 filters spam based on *different criterion*... whereas filter module RS(B) 730 may filter spam based on a mathematical *signature* (e.g., a checksum),... *Other contemplated rule handling filter modules* will filter e-mail based on... (6) feature extraction & analysis (e.g., based on phone numbers, URL’s, addresses, etc.)” (emphasis added). Thus, Aronson does not teach the identical invention in as complete detail as claim 1 because Aronson describes how each of the filter modules performs filtering based off different criteria. Aronson describes utilizing a mathematical signature as a filtering criteria as well as extraction & analysis of URLs as another filtering criteria, thus there is a filter module that filters based on mathematical signature and a filter module based on feature extraction & analysis (such as URLs). Therefore, Aronson fails to disclose where “generating one or more signatures using a length of the electronic communication and the URLs extracted”.

Further, Applicants submit that Aronson fails to disclose “generating one or more signatures using a *length of the electronic communication*” (emphasis added). Again, Aronson describes a filtering module that filters based on a mathematical signature, but “using a length of the electronic communication” is not found anywhere. Aronson describes different types of criteria used in filtering, however “a length of the electronic communication” is not one of them.

Specifically, the Examiner has stated that the “[p]hone numbers and addresses are also used, which are both a length of the electronic communication” which is incorrect. The “phone numbers and addresses” may be within an electronic communication and may also have a length, however they themselves cannot be construed as “a length”. As stated in the §112 Rejection of the Claims, this definition is contrary to that of one of ordinary skill in the art as well as common English language as defined in the Dictionary. Thus, Aronson fails to disclose “a length of the electronic communication” as well as “*generating* one or more signatures *using* a length of the electronic communication and the URLs extracted” (emphasis added).

Applicants submit that, at least for the above reasons, the 102(a) rejection has been overcome. Claim 1 and its dependent claims 2-4 and 6-9 are thus patentable and in the condition for allowance.

Claims 10 and 15 and their dependent claims 11-14 and 16-20 are patentable and in the condition for allowance for at least the same reasons set forth in claim 1.

Applicants further request withdrawal of finality as the Office Action is silent in regards to a prior art rejection of claim 5.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoiner of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 06/16/08

By / [Signature] /

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 16 day of June 2008.

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